

REMARKS

Claims 1-15 and 17-23 are currently pending. Claims 1 and 23 are currently amended. Claims 2-14 and 17-23 are original. Applicant amends independent claims 1 and 23 to include the limitations recited in dependent claim 15. Claim 15 and 16 are canceled. No new matter is added.

Rejections under 35 U.S.C §102 and §103

Claims 1-3, 6, 7, 11-14, 17-19, and 23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Steed et al. (U.S. Patent No. 5,557,813, "Steed").

Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Steed in view of Frey (U.S. Patent No. 3,732,586, "Frey").

Claims 8-10, 15 and 20-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Steed in view of Gladney et al. (U.S. Patent No. 6,772,463, "Gladney").

Response to the rejection of claims 1 and 23 under 35 U.S.C §102

Applicant believes the rejections under 35 U.S.C. §102 are moot in view of the current amendments to claims 1 and 23.

Response to the rejection of claims 1 and 23 under 35 U.S.C. §103

Applicant hereby traverses this rejection and respectfully request reconsideration thereof in light of the remarks set forth below.

The Final Office Action (see page 3, lines 3-9) states that "Steed discloses the claimed invention except for the tape or glue." The Office Action further asserts that "Gladney teaches that it is known to provide tape 50 or glue...[therefore]...it would have been obvious to one having ordinary skill in the at the time the invention was made to provide tape or glue as taught by Gladney in order to facilitate securement of a mattress core to a perimeter edging." Applicant respectfully disagrees.

Firstly, Gladney teaches attaching a “perimeter element 25” to a “foam core 20” using “planar elements 50” (see column 3, lines 44-45). The “planar elements 50” in Gladney are further disclosed as being “not limited to tape” (see column 3, line 46). Applicant submits that currently amended claim 1 recites the limitation of “...a plurality of hinges connecting...the...edge rails to the upholstery layer...wherein the hinges include tape.” Even if the “perimeter element 25” was considered equivalent to an “edge rail”, applicant points out that Gladney does not teach or suggest using the “tape 50” to connect the “perimeter element 25” (or edge rail) to an upholstery layer as recited in claims 1 and 23. Instead, Gladney merely teaches a tape 50 for securing the “perimeter element” to a “foam core”. Therefore, while Gladney does disclose a tape 50, it is instead used for connecting two elements (perimeter element and the foam core) that are not equivalent to the two elements being connected in the claimed invention. Therefore, the statement that Steed can be combined with Gladney “...to provide tape...to facilitate securement of a mattress core to a perimeter edging...” in the Office Action may be accurate, but is not a relevant argument against the claimed invention. Steed and Gladney, alone or in combination do not teach or suggest the use of a tape as a hinge for connecting the edge rails to the upholstery layer as recited in claims 1 and 23.

Moreover, as stated in the MPEP §2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Citing *In re Mills*, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990).

Gladney does not teach or suggest the planar element 50 being used as a hinge as recited in claims 1 and 23. The Office Action (see page 3, lines 11-17) states that “straps [or hinges] would allow for rails to be independently moveable.” Claims 1 and 23 recite “...the edge rails can independently move between an unassembled position and an assembled position.” The planar element 50 in Gladney is shown to be attached to the foam core and, more particularly, to both the top and bottom portions (see Figures 2 and 3). The planar element 50 in Gladney is also disclosed to “span all foam core/perimeter element interfaces...” (see column 3, lines 62-63 and Figure 1). Therefore, the planar element 50 shown in Gladney cannot be used as a hinge since the foam core and the perimeter elements cannot be independently moveable. Furthermore, since the perimeter

elements in Gladney cannot be “movably positioned” or “move between an unassembled position and an assembled position” because they are secured to the foam core. Therefore, a person of ordinary skill in the art will not be motivated to apply the tape teaching of Gladney to the strap in Steed.

There is nothing in either of the publications that would impel one of skill in the art to make the proposed combination. As such, Applicants must assume that the motivation asserted in the action was derived based on impermissible hindsight. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The extension of Steed and its combination with Gladney is clearly based on applicant's disclosure.

Response to the rejection of claim 17 under 35 U.S.C. §102

Claim 17 and dependent claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by Steed. Applicant respectfully traverses the rejection.

Applicant respectfully highlights that the Office has the initial burden of establishing anticipation, and in satisfying this burden “it is incumbent upon the Patent Office...to set forth clearly why it regards a claim to be anticipated...” *In re Mullin*, 481 F.2d 1333, 1336, 179 U.S.P.Q. 97, 100 (C.C.P.A. 1973). Applicants hold that the Examiner must distinctly point out why a reference anticipates a claim; a conclusory assertion that a particular reference anticipates a claim is not sufficient. For example, in *Mullin* the court found the Examiner's position that “Claims 1-5 are rejected as obviously anticipated by [a reference] under 35 U.S.C. 102” did not necessarily inform the Applicant why the claims were regarded as defective. *Id.* At 1336-37, 179 U.S.P.Q. at 100. Yet in the outstanding Office Action, the rationale for why Steed is offered as a basis for a 102 rejection against claim 17 is non-existent or at best incomplete.

Moreover, as stated in the MPEP §2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 17, as amended, and its dependent claims are directed to a method of assembling a mattress comprising providing an assembly including an upholstery layer and a plurality of edge rails connected to the upholstery layer by hinges, positioning the upholstery layer adjacent to a surface of a mattress core, rotating each one of the plurality of edge rails to rest adjacent to one of the plurality of edges of the mattress core and securing the plurality of edge rails to the mattress core.

Steed does not teach or suggest hinges connecting a plurality of edge rails to an upholstery layer such that each one of the plurality of edge rails is rotated to rest adjacent to one of a plurality of edges of a mattress core. For at least this reason, Steed cannot anticipate the invention claimed in claim 17. The mere observation that the figures in Steed shows edge rails, upholstery layers and straps does not provide sufficient evidence to anticipate the steps of the method of assembling a mattress as recited in claim 17.

CONCLUSION

At least for these reasons, neither Steed or Gladney or Frey, taken either alone or in combination, teach or suggest the features recited in claims 1 and 23. Accordingly, these references do not establish a prima facie case of obviousness with respect to claims 1 and 23. Therefore, claims 1 and 23 are non-obvious with respect to the art of record and should be allowed. Claims 2-15 depend, directly or indirectly, from claim 1 and are also patentable for at least for the same reasons that claims 1 is patentable. In addition, Steed does not teach or suggest each and every element as set forth in the independent claim 17. Accordingly, applicant respectfully submits that claim 17 is not anticipated by Steed and should be allowed. Since claims 18-22 depend from, and are limited by, independent claim 17, they are also patentable.

Application No. 10/761011
Amendment dated June 16, 2006
Reply to Office Action of December 19, 2005

Docket No.: SMCY-P01-102

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response other than as reflected on the enclosed Fee Transmittal. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. SMCY-P01-102 from which the undersigned is authorized to draw.

Dated: June 16, 2006

Respectfully submitted,

By 

Edward J. Kelly

Registration No.: 38,936

Customer No. 28120

FISH & NEAVE IP GROUP

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110-2624

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant